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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--------------------------|-------------|----------------------|---------------------|------------------|
| 10/790,311 | 03/01/2004 | Thomas R. Berger | 10807.0139.NPUS01 | 9331 |
| 26720 | 7590 | 03/13/2006 | EXAMINER | |
| LOCKE LIDDELL & SAPP LLP | | | PAHNG, JASON Y | |
| ATTN. DOCKETING | | | ART UNIT | |
| 600 TRAVIS #3400 | | | PAPER NUMBER | |
| HOUSTON, TX 77002 | | | 3725 | |

DATE MAILED: 03/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/790,311

Applicant(s)

BERGER ET AL.

Examiner

Jason Y. Pahng

Art Unit

3725

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 February 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8-26 is/are pending in the application.
- 4a) Of the above claim(s) 17-21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8-16 and 22-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|----------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>9/21/05 & 6/4/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Applicant's election without traverse of Group II, claims 8-26, in the reply filed on July 29, 2004 is acknowledged.

Upon additional consideration, a further restriction is required for the following patentably distinct species of the claimed invention:

Species I. Drawn to Figures including 1 and 2, and including at least claims 10-16; and

Species II. Drawn to Figures 3 and 4 and including at least claims 17-21.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 8, 9, and 22-26 are generic.

During a telephone conversation with the attorney of record, Monte R. Rhodes, on February 28, 2006, a provisional election was made with traverse to prosecute the invention of Group I, claims 1-6. Affirmation of this election must be made by applicant in replying to this Office action. Claim 17-21 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Objections

Claim 13 is objected to because of the following informalities: It appears that claim 13 should depend on claim 12 instead of claim 11. For the purposes of the

examination, claim 13 is considered to depend on claim 12 in this Office action.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 8-16 and 22-26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With regard to claim 8, there is no antecedent basis for "the first stationary plate" in line 6.

With regard to claim 9, the phrase, "the apertures define an open area in the stationary plate of" should be changed to "the sum of the open areas of the apertures in the stationary plate is" because the former is not clear and unnecessarily confusing. Additionally, the phrase, "1/3 of a surface area" (line 2) is indefinite. It should be corrected to "1/3 of the total surface area" as disclosed in the specification in page 13.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 8-12, 14-16, 22-24, and 26 are rejected under 35 U.S.C. 102(b) as being anticipated by Clements (US 3,113,735).

With regard to claim 8, Clements discloses a food waste disposer including:

1. a rotatable member (80, 99) coupled to a rotational source (45);
2. a stationary plate (62) disposed adjacent the rotatable member (80, 99) and defining a plurality of apertures (74) therethrough; and
3. wherein at least one first portion (99) of the rotatable member (80, 99) shears over (bottom of 99) at least some of the apertures (74) in the first stationary plate to shear the food waste.

With regard to claim 9, Clements discloses the sum of open areas of approximately 1/3 of the total area of the stationary plate (62) in Figure 2.

With regard to claim 10, Clements discloses a rotatable plate (80) having a central portion attached to a rotational source (45) in Figure 1.

With regard to claim 11, Clements discloses a rotatable plate (80) and a stationary plate (62) situated on a plane in Figure 1.

With regard to claim 12, Clements discloses a stationary plate (62) with a central opening (66) in which the rotatable plate (80) is positioned for rotation.

With regard to claim 14, Clements discloses one first portion (99) of the rotatable member (80, 99) comprises an impact member (99) having a surface or edge (bottom of 99) sliding on the stationary plate and passing adjacent the apertures (74) in the stationary plate.

With regard to claim 15, Clements discloses an impact member (99) comprising a lug fixedly or movably attached to the rotatable plate (80) in Figure 2.

With regard to claim 16, Clements discloses a separation distance of about 2 mm (Figure 1). It is noted that Clements may not disclose a separation distance of 2 mm, but Clements discloses a separation distance of about 2 mm.

With regard to claims 22 and 24, Clements discloses a stationary ring (36) having an inner wall disposed about the stationary plate (62), wherein at least a second portion (79) of the rotatable member (80, 99) comprises an impact member (79) having an end (79) for passing adjacent the inner wall for grinding food waste.

With regard to claim 23, Clements discloses a stationary ring (36) comprising a plurality of teeth (60 and 61) formed on the inner wall.

With regard to claims 26, Clements discloses an impact member (99) comprising a lug movably attached to the rotatable member (80).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 16 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Clements (US 3,113,735).

With regard to claim 16, alternatively, while Clements discloses the separation distance in the range of 0 to about 2 mm in Figure 1, Clements does not specifically recite it. Examiner takes an Official Notice that use of a separation distance in the range of 0 to about 2 mm is obvious to an ordinary skill in the art. Therefore, it would have been obvious to one skilled in the art at the time the invention was made to teach Clements to use a separation distance in the range of 0 to about 2 mm, as such is well known and obvious in the art.

With regard to claim 25, Examiner takes an Official Notice that use of fixed lug is obvious to an ordinary skill in the art. Therefore, it would have been obvious to one skilled in the art at the time the invention was made to teach Clements to use a fixed lug, as such is well known and obvious in the art. Furthermore, Applicant has disclosed that Applicant's invention works equally well with either a fixed lug or a movable lug.

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Clements (US 3,113,735) in view of Niekamp et al. (US 3,112,079). Claim 13 calls for a plurality of teeth around the central opening of the stationary plate. In a closely related art, Niekamp discloses a food waste disposer with a plurality of teeth (90) around the central opening in order to provide additional apertures to grind and pass material. Therefore, it would have been obvious to one skilled in the art at the time the invention was made to provide Clements with a plurality of teeth around the central opening in order to provide additional apertures to grind and pass material, as taught by Niekamp.

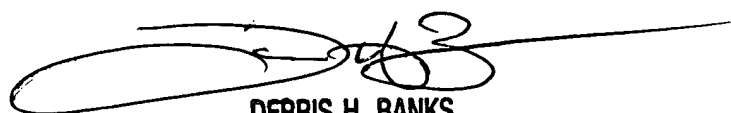
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason Y. Pahng whose telephone number is 571 272 4522. The examiner can normally be reached on 9:00 AM - 7:00 PM, Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on 571 272 4419. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JYP

A handwritten signature in black ink, appearing to read 'D. Banks', with a long horizontal line extending to the right.

DERRIS H. BANKS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700